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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/709,081      | 04/12/2004  | Craig M. Sanborn     | SANBP001US          | 1695             |

27949 7590 07/27/2007  
LAW OFFICE OF JAY R. YABLON  
910 NORTHUMBERLAND DRIVE  
SCHENECTADY, NY 12309-2814

| EXAMINER        |  |
|-----------------|--|
| BERGIN, JAMES S |  |

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3641     |              |

| MAIL DATE  | DELIVERY MODE |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/709,081 | <b>Applicant(s)</b><br>SANBORN, CRAIG M. |  |
|                              | <b>Examiner</b><br>James S. Bergin   | <b>Art Unit</b><br>3641                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/17/2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-107 is/are pending in the application.
- 4a) Of the above claim(s) 16-18, 21, 28-31, 33-43, 51-65, 81-85 and 87-107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19, 20, 22, 24-27, 32, 44-50, 66-80 and 86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 44-50** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a subassembly of the disclosed bullet that comprises **the expansion-inducing tip integral with the core material within at least part of the hollow core**, the expansion-inducing tip protruding forward of the front of the bullet, does not reasonably provide enablement for a subassembly that does not include the core material integral with the expansion tip, the core material within at least part of the hollow core and being capable of expanding radially outwardly upon impact with a target. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make an expanding projectile commensurate in scope with these claims, namely, an embodiment without the core material in the hollow core, and without such a core material being integral with the expanding tip protruding forward of the bullet, the core being capable of expanding radially outwardly upon impact with a target. Neither the elected embodiment nor the specification disclose an embodiment of the bullet subassembly in which the expanding tip is not integral with a core material or that does not protrude forward of the front of the bullet. If such an embodiment is contemplated, the applicant must now illustrate it in the

Art Unit: 3641

drawings. The limitation, "a connection", in claim 44 could be interpreted to read on a wire connecting the tip and the pressure shield, such a wire connector not being commensurate in scope with the disclosed invention.

3. **Claims 66-80** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an embodiment in which the expansion-inducing tip that is integral with the core and protrudes forward of the front of the bullet, does not reasonably provide enablement for an embodiment in which the expansion-inducing tip does not protrude forward of the front of the bullet. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Without the expansion-inducing tip protruding forward of the front of the bullet, the bullet would not be capable of expanding as intended.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-16, 19, 20, 22, 24-27, 32, 44-50, 66-80 and 86** are, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 1**, line, line 11, it is unclear whether the limitation, "a connection" refers to the "*core material*" or to some other connection?

In **claim 1**, lines 17-18 and **claim 44**, lines 9, 10, "*said connection causes said expansion-inducing tip to remain intact during the bullet's flight to a target*" is confusing.

Does the connection really keep the expansion-inducing tip intact or does it securely hold the tip in place during the bullets flight to a target?

In **claim 66**, it is unclear how the expansion-inducing tip is "*integral with a core material*" (lines 11, 12), because the claim appears to claim that there is an "*expansion tip mating extension*" inserted between the front of the hollow core and the expansion-inducing tip?

In **claim 80**, the dependency is unclear. Currently claim 80 depends upon itself.

6. **Claims 44-50** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the core material within at least a part of the hollow core.

7. **Claims 44-50** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the expanding tip being integral with the core material, the core comprising the connection between the expansion-inducing tip and the pressure shield.

8. **Claims 66-80** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the expansion-inducing tip protruding forward of the front of the bullet.

***Allowable Subject Matter***

9. Claims 1-16, 19, 20, 22, 24-27, 32 and 86 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 571-272-6872. The examiner can normally be reached on Monday - Wednesday and Friday, 8.30 - 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James S. Bergin  
Primary Examiner  
Art Unit 3641

/James Bergin/